REMARKS

The specification is objected to for an incorrect Provisional Patent Application Serial Number. The Applicant requests the correct Application Number be inserted into the Specification. Further, the Claims 14 to 36 are numbered incorrectly and the Applicant agrees with the Examiner's renumbering.

Claims 31 to 37 stand rejected under 35 U. S. C. 112, first paragraph, as containing subject matter which was not described in the specification. Claims 30 to 37 have been canceled thereby obviating this rejection. Claims 1 to 20 stand rejected under 35 U. S. C. 112, second paragraph, as being indefinite. Claims 1, 5, 10, 11 and 14 have been amended to particularly point out and distinctly Claim subject matter which the Applicant regards as the invention.

Claims 1 to 37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,940,821 issued to Wical in view of U.S. Patent Number 6,023,659 issued to Seilhamer et al. Claims 1, 5, 10, 11, 14 and 20 have been amended and Claims 30 to 37 have been cancelled. Since independent Claims have been amended and are now allowable, it follows that all respective depending Claims are also allowable.

The Claims stand rejected under 35 USC 103(a) as being unpatentable over U.S. Patent Number 5,940,821 issued to Wical in view of U.S. Patent Number 6,023,659 issued to Seilhamer et al. The Claims have been amended to positively state the searching of bioinformatics data. The Applicant respectfully reminds the Examiner that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or

establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the cited references themselves or in knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claimed limitations.

The teachings or suggestions to make the claimed combination and the reasonable expectation of success must be found in the prior art not based on the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP 706.02 (j).

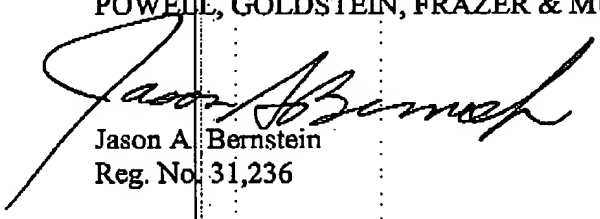
The references of record simply do not teach, suggest or disclose the presently claimed invention, either individually or in combination. It is respectfully submitted that the Examiner has not established a case of *prima facia* obviousness and is using hindsight contrary to the mandate of the Court of Appeals for the Federal Circuit in making a § 103 rejection. The Courts have held in all determinations under 35 USC § 103 that the decision maker must bring judgment to bear. It is *impermissible*, however, to engage in a hindsight reconstruction of the claimed invention using the Applicant's methodology as a template and selecting steps from references to fill the gaps.

Most recently the Court of Appeals for the Federal Circuit (CAFC) has ruled that a critical suggestion to modify the prior art to arrive at a claim must be supported by some evidence in the prior art references *In re Dembiczak*, 175 F.3d 994, 50 USPQ 2d 1614 (Fed. Cir. 1999). This ruling by the CAFC is not new; the Courts have consistently ruled an explicit teaching must be delineated in the prior art references.

collectively, without the benefit of hindsight vision afforded by the Applicant's disclosure, do not disclose or suggest the Claimed invention.

In view of the foregoing amendments to the Claims and associated remarks, Applicant respectfully requests the Examiner pass this case to issue. If, in the opinion of the Examiner, a telephone conference would expedite the issuance of this application, the Examiner is invited to call the undersigned Attorney.

Respectfully submitted,
POWELL, GOLDSTEIN, FRAZER & MURPHY LLP



Jason A. Bernstein
Reg. No. 31,236

16th Floor
191 Peachtree Street, NE
Atlanta, GA 30306-1736
(404) 572-6900
jbernstein@pgfm.com